



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/625,597

07/24/2003

William Patrick Tunney

11884/404401

7932

23838

7590

09/26/2006

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER

PATEL, SHEFALI D

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,597	TUNNEY, WILLIAM PATRICK	
	Examiner	Art Unit	
	Shefali D. Patel	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 9-10 and 17-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-7 and 16-17, respectively of copending Application No. 10/625,659. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims recite “date” and the copending application recites “time”. The two are similar when it comes to its definition. Date is described as “the time or period to which any event or thing belongs” according to www.dictionary.com. Therefore, they are obvious over the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Dependent claims 11-16 are rejected for the same reasons.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (hereinafter, "Wolff") (US 6,081,261) in view of Ericson (US 6,666,376).

With regard to **claim 1** Wolff discloses a method comprising (Figures 1 and 5): receiving capture data from a capture device, wherein the capture data is captured simultaneously with writing made on a paper form (col. 3 lines 26-65, col. 7 lines 6-9 and col. 9 lines 44-46); comparing the capture data with one of a plurality of unique positions stored in memory in association with a plurality of calendar dates (col. 5 lines 22-26 and the calendar book information is disclosed at col. 3); retrieving from memory the calendar date associated with the unique position that matches the capture data (col. 5 lines 48-55 and lines 1-6). Wolff does not expressly disclose storing the retrieved calendar date in memory as the writing made on the paper form. Ericson discloses this at col. 7 lines 25-38 and also on col. 5 lines 29-39. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ericson with Wolff. The motivation for doing so is to determine the unique time period, which identifies the first calendar area, thereby enabling the creation of an electronic back-up of the calendar as suggested by Ericson. Therefore, it would have been obvious to combine Ericson with Wolff to obtain the invention as specified in claim 1.

With regard to **claims 2 and 3** both Wolff and Ericson discloses the coordinates (x,y) and (x,y,t). Wolff at col. 7 lines 21-22, col. 8 lines 7-17, 26, 37 and 45. See, Ericson at col. 7 line 46.

Claim 4 is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 4. Claim 4 distinguishes from claim 1 only in that it recites the

Art Unit: 2624

capture data representing positions of a set of marks made on paper overlaying a face of the capture device. Both Wolff and Ericson teach the position data and the code to recognize. See Wolff at col. 5 lines 1-30 and Ericson at col. 6 lines 40-65.

Claims 5-6 recites identical features as claims 2-3. Thus, arguments similar to that presented above for claims 2-3 is equally applicable to claims 5-6.

With regard to **claim 7** Wolfe discloses the capture data captured simultaneously with the making of the set of marks on the paper (col. 2 lines 48-56, col. 4 lines 21-23).

With regard to **claim 8** Wolff discloses receiving a set of points from the capture device, the set of points representing orientation of the paper on the capture device; and determining the positions of the set of marks relative to the set of points (col. 8 lines 40-63).

Claim 9 is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 9. Claim 9 distinguishes from claim 1 only in that it recites mapping the set of coordinates to a data. Ericson discloses this at col. 6 lines 26-39 and line 66 to col. 7 line 20.

Claim 10 is the same as claim 3 where the time was included in the vector.

With regard to **claim 11** Wolff discloses three groups of boxes, which includes months, days and one of the years at col. 3 lines 32-34.

With regard to **claim 12** Wolff discloses checking on box from each of the first, second and third groups. See element 13 in Figure 1, which is a code representing data (year, month and day). Figure 1 represents one page from the calendar book representing that day, date and time.

With regard to **claim 13** Wolff discloses resolving the checking of multiple boxes within one of the first, second, or third groups, including receiving multiple sets of coordinates corresponding to the multiple boxes, and determining which of the multiple sets of coordinates was captured by the capture

Art Unit: 2624

device last (note, at col. 5 lines 31-36 knowing the index I sub k and the limits defining I sub k is how the beginning and end of the message is determined. Further disclosed at col. 5 lines 48-67).

With regard to **claim 16** Wolff discloses the paper data form attached to the capture device, the form including a calendar displaying the days in a month (see Figure 1). Ericson discloses this as seen in Figures 1 and 8.

Claim 17 is rejected the same as claim 9 except claim 17 is a system claim. Thus, arguments similar to that presented above for claim 9 is equally applicable to claim 17. Note, Wolff discloses a memory and a processor along with a display as seen in Figure 5 and its respective portions in the specification.

Claim 18 is the same as claim 3 where the where and when was included in the vector (i.e., x,y,t).

Allowable Subject Matter

5. Claims 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest prior art to Wolff and Ericson are directed to the method and system as disclosed in independent claims 1, 4, 9 and 17. However, the closest prior art fails to disclose anything about *the mapping including retrieving from memory predefined coordinates indicating where each set of marks corresponding to a date is expected to be made on the capture device; comparing the set of coordinates to the predefined coordinates; determining which of the predefined coordinates is the closest match to the set of coordinates; and storing the date corresponding to the determined predefined coordinates* as disclosed in claim 14. It is for these reasons in combination with all the other elements of the claim that claims 14-15 would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims. Dependent claim 15 would be allowable for the same reason as claim 14

Art Unit: 2624

Conclusion

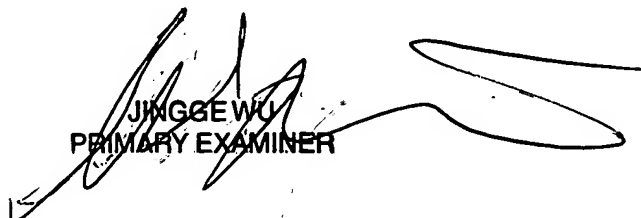
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shefali D Patel
Examiner
Art Unit 2624

sdp


JINGGE WU
PRIMARY EXAMINER